

Application No. 10/675,820
Amendment dated November 14, 2007
Reply to Office Action of October 16, 2007

claimed invention and the prior art, (3) the level of ordinary skill in the pertinent art, and (4) where in evidence, so-called secondary considerations. (Graham v. John Deere, at 17-18, 148 U.S.P.Q. at 467). However, even under Graham v. John Deere, a combination of references that teach away from the claimed invention support a finding of nonobviousness. As discussed below, Cauthen and Zucherman teach away from one another. Accordingly, Applicant submits that a *prima facie* case of obviousness based on a combination of Cauthen and Zucherman cannot be made.

Cauthen teaches an insertion instrument (10) of Figs. 1 and 2 having a hollow body (12), and a handle (18) with a guide (20) extending therefrom pivotal about an articulating hinge (22), where the hinge (22) has a pivot axis disposed on the exterior of the hollow body (12). Cauthen also teaches an insertion instrument (10) of Figs. 13 and 14 having a hollow body, and a handle (18) with an associated guide (20) and a handle (37) with an associated guide (35) pivotal about articulating hinges (22) and (36), respectively. The hinges (22) and (36) have pivot axes disposed on the exterior of the hollow body. As such, unlike the guard recited in independent claim 1, Cauthen teaches that the handle (18) and the guide (20) in Figs. 1 and 2, and the handles (18) and (37) and the associated guides (20) and (35) in Figs. 13 and 14, respectively, pivot about axes that lie outside any pathways through insertion instruments (10) leading to adjacent vertebral bodies and a disc space therebetween (Emphasis added).

The Examiner acknowledges the above-discussed teachings of Cauthen. The Examiner indicates that "Cauthen et al. disclose the claimed invention except for more specifically an axis that passes through at least a portion of the pathway, allowing the two portions to articulate and distract vertebrae." According to the Examiner, "Zucherman et al. in Fig. 13 shows a distraction mechanism that distracts vertebrae (88/90) (sic) via a point that extends as an axis through at least a portion of the pathway," and "though Zucherman et al. discloses (sic) a device that appears to have two intersecting halves, it teaches an axis that at least passes through a portion of the pathway." Contrary to the Examiner's contentions, however, Cauthen and Zucherman teach away from one another.

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In Fig. 13, Zucherman teaches a spreader or distraction tool (80) including first and second arms (82) and (84) pivotal about a pivot point (86). The first and second arms (82) and (84) are rod-like levers including L-shaped ends (88) and (90). The L-shaped ends (88) and (90) bear against first and second spinous processes (92) and (94), and, when the spreader (80) is actuated, the spinous processes (92) and (94) are distracted. During distraction the spinous processes (92) and (94) are distracted. An Implant (96), as shown in Fig. 10 of Zucherman, can be inserted between the spinous processes. Given that the first and second arms (82) and (84) of the spreader (80) are rod-like levers, Zucherman does not teach use of a hollow body for receiving an implant therethrough. Instead, Zucherman teaches that the first and second arms (82) and (84), rather than the hollow bodies of the insertion instruments (10) of Cauthen, are sufficient for facilitating implantation of the Implant (96).

Because the radically different ways that Cauthen and Zucherman facilitate implantation, one teaching use of a hollow body for receiving an implant therethrough and the other teaching that such a hollow body is unnecessary, Applicant submits that Cauthen and Zucherman teach away from one another. Therefore, the rejection of independent claim 1 based on the combination of Cauthen and Zucherman cannot be maintained. Accordingly, independent claim 1 is patentable over the Examiner's rejection under 35 U.S.C. § 103(a) based on the combination of Cauthen and Zucherman.

In addition, the Examiner rejected claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Cauthen and Zucherman as applied to claim 21 above further in view of U.S. Publication No. 2003/0023209 to Gruskin et al. ("Gruskin"); and the Examiner rejected claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Cauthen and Zucherman as applied to claim 21 above further in view of U.S. Publication No. 2003/0229401 to Mansourt et al. ("Mansourt"). Applicant submits that the rejections of claims 29 and 30 are rendered moot at least because these claims depend from an allowable independent claim, or claims dependent therefrom.

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In conclusion, Applicant submits that independent claim 1 is patentable and that dependent claims 2-30 dependent from independent claim 1, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim. Accordingly, in view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. It is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

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